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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,226	08/01/2001	Kazuyuki Uchida	NAK1-BP60	5849
21611	7590	07/13/2006	EXAMINER	
SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			MITCHELL, JASON D	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,226	UCHIDA ET AL.	
	Examiner	Art Unit	
	Jason Mitchell	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 12, 21 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 12, 21 and 23-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to an amendment filed 3/21/06.

At applicant's request, claims 1-4, 6, 11, 13-14, 18-20 and 22 have been canceled.

Claims 23-39 have been added. Claims 7, 12, 21 and 23-39 are pending in this application.

Response to Arguments

Applicant's arguments filed 3/21/06 have been fully considered but they are not persuasive.

Starting at the top of pg. 12 Applicant states:

The [Sonderegger] disclosure does not disclose or suggest Applicant's check script preprocessing that occurs prior to the download of a program.

Claims 7 and 12 recite a "judging means for judging from a result of an (the) execution of the received check script whether the receiving apparatus can execute the download-target program". ... The cited passages refer to an application launcher 50 and a second querying step 190 that is part of a startup script during application launch, (*Sonderegger*, Column 18, Lines 51-53 and Column 21, Lines 51-53) Second querying step 190 appears in figure 11 which illustrates the structure of each of steps 176, 178, and 182 that occur on application launch, (*Sonderegger*, Column 18, Lines 51-53). Thus the cited passages refer to a single executable script that begins at application launch. Applicant's recited check script and target program are two independent executables making the recited claim patentable over *Sonderegger*.

Examiner respectfully disagrees. In col. 3, lines 37-48 *Sonderegger* discloses "the launcher uses the information in the application's database object to setup execution environment resources needed by the application", further this 'information in the application's database' comprises the cited 'startup script' see col. 14, lines 24-25.

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It should be clear from this disclosure that 'the launcher' performs the 'set up' prior to actually launching the applications. In other words, if the application's required 'execution environment' is not 'set up' the application cannot run.

Accordingly the rejections of claims 7, 12 and 21 are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 34 recites limitations regarding a "television genre" and Claim 39 recites "resolution or quality of the television programs". Examiner could find no disclosure of this subject matter in Applicant's specification.

Claim 39 recites the limitations "The method for downloading television programs", "the list of viewable television programs" and "the resolution or quality". There is insufficient antecedent basis for this limitation in the claim.

It is Examiner's assumption that this claim was intended to depend, directly or indirectly from claim 33, which would provide antecedent basis for "The method for downloading television programs" and "the list of viewable television programs" but not "the resolution or quality".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 7, 12 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,692,129 to Sonderegger et al. (Sonderegger).

Regarding Claims 7, 12 and 21: Sonderegger discloses a transmitting apparatus comprising: *program holding means for holding one or more programs and identifications thereof.*

"centrally managing application programs in a computer network" (col. 2, lines 47-49)

Check script holding means for holding one or more check scripts, which correspond to the one or more programs and are each used to check whether the receiving apparatus has either of a device function and an embedded-program function that is necessary for an execution of a corresponding program.

'The steps 108 and 110 define and add a "startup script"' (col. 14, lines 24-25); "A drive mapping step 176 follows the sequence described in Fig. 11" (col. 20, lines 22-35).

Request receiving means for receiving either a check script request or a program request from the receiving apparatus.

"select a specific application 23 and order the launcher 50 to perform an application launching step 150" (col. 18, lines 51-53)

Transmitting means for either (a) reading from the check script holding means a check script corresponding to an identification contained in the received check script request and transmitting the read check script to the receiving apparatus, or (b) reading from the program holding means a program corresponding to an identification contained in the received program request, and transmitting the read program to the receiving apparatus.

"select a specific application 23 and order the launcher 50 to perform an application launching step 150" (col. 18, lines 51-53)

A receiving apparatus comprising: first request transmitting means for transmitting to the transmitting apparatus the check script request that contains the identification of a download-target program. Check script receiving means for receiving the check script sent from the transmitting apparatus in response to the check script request. Judging means for judging from a result of an execution of the received check script whether the receiving apparatus can execute the download-target program.

"select a specific application 23 and order the launcher 50 to perform an application launching step 150" (col. 18, lines 51-53); "A drive mapping step 176 follows the

sequence described in Fig. 11" (col. 20, lines 22-35); "passes control to an error reporting step 196 if the drive assignments already made differ from those requested in a manner that prevents any drive listed in the drive mappings attribute from being mapped" (col. 21, lines 28-32)

Second request transmitting means for, when the judging means judges that the receiving apparatus can execute the download-target program, transmitting the program request containing the identification of the download-target program.

"the drive mapping step 176 ... passes control to an error reporting step 196 if the drive assignments already made differ from those requested in a manner that prevents any drive listed in the drive mappings attribute from being mapped" (col. 21, lines 28-32).

Program receiving means for receiving a program that is sent from the transmitting apparatus in response to the program request.

"select a specific application 23 and order the launcher 50 to perform an application launching step 150" (col. 18, lines 51-53)

Claims 24-26, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,594,699.

Regarding Claim 24: Sahai discloses a method for downloading television programs to a set top box. (col. 3, lines 25-28 "Client hardware type such as TV set top") comprising:
Generating resource information about the set top box environment; Sending a download request to a cable station comprising the resource information and a television program identifier;

'not only does this "play" request get shipped across the server 10- ... but along with it ... a set of "capabilities" of the client 12 are also shipped' (col. 3, lines 5-10).

Note that in order to send Sahai's 'set of capabilities' the set must first have been generated.

Reading program attributes of a television program corresponding to the television program identifier; Comparing the resource information with the program attributes to determine if the set top box environment has adequate resources to receive the television program; Downloading the television program if the set top box has adequate resources to receive and execute the television program.

"The server 10 ... picks the appropriate media asset or real time file having the appropriate format type ... the asset is chosen based on the client side information ... Given the CPU processing power, the software and hardware capabilities of the client 12, the server 10 can determine whether the client 12 will be able to [cope with] media decoding on a timely basis" (col. 6, lines 12-49).

Regarding Claim 25: The rejection of claim 24 is incorporated; further Sahai discloses the resource information includes information about the available memory (col. 3, line 29 "Volatile and non-volatile memory/storage speed").

Regarding Claim 26: The rejection of claim 24 is incorporated; further Sahai discloses the resource information includes information about operating system tasks to be executed (col. 3, lines 30-31 "type and version of operating system").

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Regarding Claim 30: The rejection of claim 24 is incorporated; further Sahai discloses the program attributes include program memory requirements (col. 3, line 29 "Volatile and non-volatile memory/storage speed"). Note that in Sahai's system a program "is chosen based on the client side information" (Col. 6, lines 12-49). This indicates a comparison between the resource information and corresponding program requirements.

Regarding Claim 31: The rejection of claim 24 is incorporated; further Sahai discloses the program attributes include operating system requirements (col. 3, lines 30-31 "type and version of operating system").

Regarding Claim 32: The rejection of claim 24 is incorporated; further Sahai discloses receiving the television program identifier from an interface unit (col. 3, lines 5-10 'playback any video/multimedia asset by "clicking on" it in the client 12').

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,594,699 to Sahai et al. (Sahai) in view of US 6,785,716 to Nobakht (Nobakht).

Regarding Claim 27: The rejection of claim 24 is incorporated; further Sahai discloses the download request further comprises a set top box identifier (col. 5, lines 38-41 "This contact specifies ... the IP address and port number in the client").

Sahai does not explicitly disclose that this identifier a set top box serial number.

Nobakht teaches identifying a set top box by its serial number (col. 7, lines 21-23 "information that identifies set-top box 131, such as serial number 342")

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use a set top box serial number (Nobakht col. 7, lines 21-23) as part of the 'contact' disclosed by Sahai (col. 5, lines 38-41) in order to specify the client capabilities (Sahai col. 5, lines 38-41).

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,594,699 to Sahai et al. (Sahai) in view of US 6,421,726 to Kenner et al. (Kenner)

Regarding Claim 28: The rejection of claim 24 is incorporated; further Sahai does not explicitly disclose sending a message from the cable station to the set top box if adequate resources are not available but does disclose determining if adequate resources are available (col. 6, lines 35-38 "Given the CPU processing power, the software and hardware capabilities of the client 12, the server 10 can determine whether the client 12 will be able to [cope with] media decoding on a timely basis")

Kenner teaches sending a message from the cable station to the set top box if adequate resources are not available (col. 16, lines 52-65 'displays a message ... advising the user that the download is not permitted').

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In a case where Sahai's cable station ('server 10') determined there were no 'appropriate media assets' (Sahai col. 6, lines 12-16) and/or the set top box 'will [not] be able to [keep] up with media decoding on a timely basis' (Sahai col. 6, lines 35-38), it would have been obvious to a person of ordinary skill in the art at the time of the invention to send a message to the set top box, as taught in Kenner (col. 16, lines 52-65) in order to advise the user that no download is available (Kenner col. 16, lines 62-65 'advising the user that the download is not permitted').

Regarding Claim 29: The rejection of claim 28 is incorporated; further Kenner teaches displaying the message on an interface unit (col. 6, lines 62-65 'displays a message').

Claims 23, 33, 35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,594,699 to Sahai et al. (Sahai) in view of US 7,000,243 to Fenwick et al. (Fenwick).

Regarding Claim 23: Sahai discloses an audio visual download apparatus comprising:

A receiving apparatus having a request transmitting unit that transmits requests for audio visual programs including a program identifier and information about the resources available to the receiving apparatus for executing the audio visual content;
'not only does this "play" request get shipped across the server 10- ... but along with it ... a set of "capabilities" of the client 12 are also shipped' (col. 3, lines 5-10)

A transmit apparatus having; a request receiving unit that receives requests from the request transmitting unit; a program library that contains a plurality of audio visual

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programs; a check script holding means that holds a plurality of scripts for checking the resources available;

"a media server process 40 Upon receiving 42 the URL, play request and capability/preference information, picks the appropriate media asset ... to stream to the client 12." (col. 6, lines 12-23)

A selecting unit operatively connected to the check script holding means to compare the contents of a request received by the request receiving unit with the audio visual programs in the program library and if there is not enough resources available to execute the audio visual program corresponding to the program identifier.

"The server 10 ... picks the appropriate media asset or real time file having the appropriate format type ... the asset is chosen based on the client side information ... Given the CPU processing power, the software and hardware capabilities of the client 12, the server 10 can determine whether the client 12 will be able to [cope with] media decoding on a timely basis" (col. 6, lines 12-49).

A transmitting unit that transmits to the receiving apparatus;

"send or stream an application to the client ... in response to the initial HTTP request" (col. 6, lines 60-63)

A user interface unit; wherein a user may select, with the user interface unit, one of the audio visual programs for download and send the related audio visual program to the transmit apparatus to enable downloading of the selected audio visual programs for execution by the receiving apparatus.

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'When the use wants to playback any video/multimedia asset by "clicking-on" it in the client not only does this "play" request get shipped across the server 10- ... but along with it ... a set of "capabilities" of the client 12 are also shipped' (col. 3, lines 5-10

Sahai does not explicitly disclose sending a list of viewable television programs to the set top box but does disclose means of retrieving user preferences (col. 6, line 64 – col. 7, line 7 "asking (prompting) the user ... for user specifications/preferences").

Fenwick teaches *generating a listing of compatible audio visual programs that can be executed with the resources and a sub-listing of the choice of audio video characteristics available for each audio visual program.*

"This data preferably includes a list of available program material titles, program material start and end times, the identification of the communications channel assigned to it and the current audiovisual serving device configuration. The list of available program material is used to generate menus for selection by users" (col. 7, line 64-col. 8, line 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to present a list to the user as taught by Fenwick (col. 7, line 64-col. 8, line 2) using Sahai's transmitting means (col. 6, lines 60-63) in order to present options to the user (Sahai col. 6, line 64 – col. 7, line 7 "asking (prompting) the user ... for user specifications/preferences") while ensuring that the client 12 will be able to [cope with] media decoding on a timely basis" (Sahai col. 6, lines 12-49; also see Fenwick col. 5, lines 22-26 "The list can vary in concert with the available system resources").

Regarding Claim 33: Sahai discloses a method for downloading television programs to a set top box. (col. 3, lines 25-28 “Client hardware type such as TV set top”) comprising: *Generating resource information about the set top box environment; Sending a download request to a cable station comprising the resource information and a request identifier;*

‘not only does this “play” request get shipped across the server 10- ... but along with it ... a set of “capabilities” of the client 12 are also shipped’ (col. 3, lines 5-10).

Note that in order to send Sahai’s ‘set of capabilities’ the set must first have been generated.

Reading program attributes of television programs that correspond to request identifier at the cable station; Comparing the resource information with the program attributes to identify television programs that can be viewed in the set top environment.

“The server 10 ... picks the appropriate media asset or real time file having the appropriate format type ... the asset is chosen based on the client side information ... Given the CPU processing power, the software and hardware capabilities of the client 12, the server 10 can determine whether the client 12 will be able to [cope with] media decoding on a timely basis” (col. 6, lines 12-49).

Sahai does not explicitly disclose sending a list of viewable television programs to the set top box but does disclose means of retrieving user preferences (col. 6, line 64 – col. 7, line 7 “asking (prompting) the user ... for user specifications/preferences”).

Fenwick teaches *sending a list of viewable television programs to the set top box*

"The list of available program material is used to generate menus for selection by users" (col. 7, line 64-col. 8, line 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to present a list to the user as taught by Fenwick (col. 7, line 64-col. 8, line 2) in order to present options to the user (Sahai col. 6, line 64 – col. 7, line 7 "asking (prompting) the user ... for user specifications/preferences") while ensuring that the client 12 will be able to [cope with] media decoding on a timely basis" (Sahai col. 6, lines 12-49; also see Fenwick col. 5, lines 22-26 "The list can vary in concert with the available system resources").

Regarding Claim 35: the rejection of claim 33 is incorporated; further Sahai discloses the resource information includes an operating system or a memory availability ((col. 3, line 29 "Volatile and non-volatile memory/storage speed").

Regarding Claim 37: The rejection of claim 33 is incorporated; further Sahai discloses user interaction is preformed on a television or an interface unit (col. 6, lines 62-65 'displays a message'); selecting a television program; sending a television program identifier to the cable station (col. 3, lines 5-10 'playback any video/multimedia asset by "clicking on" it in the client 12'); downloading the television program (col. 6, lines 47-49 "sends 56 the data to the client 12").

Regarding Claim 39: The rejection of claim 33 is incorporated; further Sahai discloses the set of user preferences includes the resolution or quality of the television programs (col. 3, lines 50-56 'the size of the displayed video frame').

Accordingly it would have been obvious to a person of ordinary skill in the art at the time of the invention to present this information in Fenwick's menu system (col. 4, line 66 - col. 5, line 3)

Claims 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,594,699 to Sahai et al. (Sahai) in view of US 7,000,243 to Fenwick et al. (Fenwick) further in view of US 6,678,891 to Wilcox et al. (Wilcox).

Regarding Claim 34: The rejection of claim 33 is incorporated; further the Sahai-Fenwick combination does not disclose the request identifier includes a television genre, but Fenwick teaches the use of a menu system (col. 4, line 66 - col. 5, line 3 "the user is guided through a menu-driven process").

Wilcox teaches a request identifier including a television genre (Fig. 8).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use television genres, as taught by Wilcox (Fig. 8), in the menu system taught by Fenwick (col. 4, line 66 - col. 5, line 3)

Regarding Claim 38: The rejection of claim 37 is incorporated; further Sahai-Fenwick combination does not disclose the television program includes supplemental program information.

Wilcox teaches a television program includes supplemental program information (Fig. 11).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include supplemental program information, as taught by Wilcox (Fig. 11), in the menu system taught by Fenwick (col. 4, line 66 - col. 5, line 3)

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,594,699 to Sahai et al. (Sahai) in view of US 7,000,243 to Fenwick et al. (Fenwick) further in view of US 6,785,716 to Nobakht (Nobakht).

Regarding Claim 36: The rejection of claim 33 is incorporated; further Sahai does not explicitly disclose that this identifier a set top box serial number.

Nobakht teaches identifying a set top box by its serial number (col. 7, lines 21-23 "information that identifies set-top box 131, such as serial number 342")

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use a set top box serial number (Nobakht col. 7, lines 21-23) as part of the 'contact' disclosed by Sahai (col. 5, lines 38-41) in order to specify the client capabilities (Sahai col. 5, lines 38-41).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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7/7/06



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